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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/550,949	05/02/2006	Andreas Michl	01012-1024	4083
36671 7590 10/27/2008 DITTHAVONG MORI & STEINER, P.C. 918 Prince St. Alexandria, VA 22314				
EXAMINER MCLEOD, MARSHALL M				
ART UNIT		PAPER NUMBER		
2457				
MAIL DATE		DELIVERY MODE		
10/27/2008		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/550,949

**Applicant(s)**

MICHL, ANDREAS

**Examiner**

MARSHALL MCLEOD

**Art Unit**

2457

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 02 May 2006.  
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-12 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 1-12 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.  
10) ☒ The drawing(s) filed on 27 September 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)  
3) ☒ Information Disclosure Statement(s) (PTO-850)  
Paper No(s)/Mail Date 04/24/2006, 09/27/2005  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_  
5) ☐ Notice of Informal Patent Application  
6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

1. Claims 1-12 are pending in this application.

***Priority***

2. Examiner acknowledges applicant's foreign priority based on PCT App. No. PCT/EP2004/001225, filed February 10, 2004.

***Claim Rejections - 35 USC § 101***

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. With respect to claims 10 and 11, the claims lack the necessary physical articles or objects to constitute a machine or a manufacture within the meaning of 35 USC 101. They are clearly not a series of steps or acts to be a process nor are they a combination of chemical compounds to be a composition of matter. As such, they fail to fall within a statutory category. It is important to note that "Software per se" is non-statutory under 35 USC 101 because it is merely a set of instructions without any defined tangible output or tangible result being produced. The requirement for tangible result under 35 USC 101 is defined in *State Street Bank & Trust Co. v. Signature Financial Group Inc.*, 149 F.3d 1368, 47USPQ2d 1596 (Fed. Cir. 1998).

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(c) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. **Claims 1-12 are rejected under 35 U.S.C. 102(e) as being anticipated by Birsan et al. (Patent No US 6,848,078 B1), hereinafter Birsan.**

7. With respect to claim 1, Birsan discloses a method for determining deviations of an end-system message of modular structure generated in a hierarchically-structured end system of a telecommunications device (Abstract, lines 1-3) by comparison with a reference message (Column 5, lines 15-27) comprising the steps of: reading in a reference message (Column 8, lines 43-49), reading in an end-system message (Column 9, lines 10-17) generated in the end system, performing a message-structure analysis of the reference message (Column 8, lines 43-49), performing a message-structure analysis of the generated end-system message (Column 9, lines 10-17), determining deviations of the end-system message from the reference message (Column 4, lines 37-57) based on a structure and values for parameters of structural units (Column 6, lines 30-41 and Column 7, lines 3-12; also See Figure 3, item (42) and (52)), and, outputting structural units deviating from the reference message indicating values of parameters of respective structural units (Column 6, lines 30-41 and Column 7, lines 3-12; also See Figure 3, item (42)

and (52)) of the end-system message (Column 6, lines 43-47; Column 8, lines 58-59; also See Figure 3) generated in the end system (Column 9, lines 10-17).

8. With respect to claim 2, Birsan discloses identical structural units of the reference message and of the end-system message generated in the end system output, wherein the structural units of the end-system message deviating from the reference message are output in a manner graphically distinguishable from the identical structural units (Column 6, lines 14-24).

9. With respect to claim 3, Birsan discloses structural units only present in the reference message are output in a manner graphically distinguishable from structural units other than the structural units only present in the reference message (Column 6, lines 14-24).

10. With respect to claim 4, Birsan discloses structural units only present in the generated end-system message are output in a manner graphically distinguishable from structural units other than the structural units only present in the generated end- system message (Column 6, lines 14-24).

11. With respect to claim 5, Birsan discloses the structural units at least of the end-system message are output in a manner corresponding to a modular construction (Column 2, lines 55-61).

12. With respect to claim 6, Birsan discloses the outputting is provided in a first region of a screen display (Column 6, lines 17-21; see also Figure 3).

13. With respect to claim 7, Birsan discloses the structural units of the end-system message are output in a second region with an indication of information regarding a data stream of the end-system message, wherein structural units deviating from the reference message are output in a manner distinguishable from structural units of the second region other than the structural units deviating from the reference message (Column 2, lines 6-17).

14. With respect to claim 8, Birsan discloses the structural units of the end-system message are output in a third region with an indication of information of a data stream of the reference message, wherein structural units deviating from the reference message are output in a manner distinguishable from structural units of the third region other than the structural units deviating from the end-system message (Column 2, lines 6-17).

15. With respect to claim 9, Birsan discloses a digital storage medium with electronically-readable control signals, configured to co-operate with a programmable computer or digital signal processor (Column 9, lines 18-25).

16. With respect to claim 10, Birsan discloses computer software with program-code means for the implementation of the method according to claim 1, when the software is run on a computer or a digital signal processor (Column 9, lines 26-34).

17. With respect to claim 11, Birsan discloses computer software with program-code means, for the implementation of the method according to claim 1, when the software is stored on a machine-readable data carrier (Column 9, lines 18-25).

18. With respect to claim 12, Birsan discloses computer software product with program-code means stored on a machine-readable data carrier, for the implementation of the method according to claim 1, when the software is run on a computer or a digital signal processor (Column 9, lines 26-34).

### *Conclusion*

19. Any inquiry concerning this communication or earlier communications from the examiner should be directed to MARSHALL MCLEOD whose telephone number is (571)270-3808. The examiner can normally be reached on Monday - Thursday 6:30 a.m-4:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ario Etienne can be reached on (571) 272-4001. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Marshall McLeod

/ARIO ETIENNE/

Supervisory Patent Examiner, Art Unit 2457